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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/066,379      | 01/30/2002  | Thomas C. McFarland  | 100200351-1         | 4528             |

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HEWLETT-PACKARD COMPANY  
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EXAMINER

PHAM, HAI CHI

ART UNIT PAPER NUMBER

2861

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/066,379

Applicant(s)

McFARLAND ET AL.

Examiner

Hai C Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-11, 14-25, 33-37, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-11, 14-17, 33-37, 39 and 40 is/are allowed.
- 6) ☒ Claim(s) 18-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## FINAL REJECTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 18-19, 22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark (U.S. 6,511,731) in view of Van Valer (Pub. No. U.S. 2002/0145614).

Clark discloses a label (10) that affixes to a storage media (optical disc 20), the label comprising a first side (side facing the optical disc) for affixing said label to said storage media (the label being adhered to the optical disc), a second side, wherein images (text and/or graphic) are printed on said second side and wherein said images are printed within an area that is substantially larger than the area required to cover at least one side of said storage area (the text and/or graphic being printed on the area covering the hole 23 of the optical disc) (Figs. 6-8, 13).

However, Clark fails to teach the printed images and a title corresponding to images and title encoded on the storage media (claims 18, 22), the label including at least one image that does not correspond to an image encoded on the storage media (claim 24), and image that represents a musical selection encoded on said storage media (claim 25).

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Van Valer discloses a method for labeling of photo compact discs with a photo table of contents, the method consisting of selecting the digital photos to be stored on a target photo compact disc and designing the photo table contents label that will be printed onto that target photo compact disc as a label, which has adhesive on one side to be affixed to the compact disc. Van Valer further teaches printing a title (album title) onto the label, the title being encoded on the compact disc or received from a user's input (paragraph [0062]), printing an arbitrary user-specified image on the label (paragraph [0081]), printing individual recordings of the music CD so that the consumer can quickly find any specific song (paragraph [0009]).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Clark to include images and title pertinent to the content of the CD to be printed on the label as taught by Van Valer. The motivation for doing so would have been to allow the consumer to quickly identify any particular optical disc.

3. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Van Valer, as applied to claim 18 above, and further in view of Tracy (U.S. 5,770,289).

Clark, in view of Van Valer, discloses all the basic limitations of the claimed invention except for the label having grooves that permit portion of the label to be separate from the backing material, the groove having the shape of the disk.

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Tracy teaches a die cut self-adhesive label sheet for labeling CD-ROMs, the label sheet being provided with a groove that traces the shape of the CD-ROM such that the printing of the entire label is allowed while the label sheet is fed through the printer paper feed mechanism.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the label on a label sheet with groove delimiting the label portion as taught by Tracy in the modified device of Clark. The motivation for doing so would have been to provide printing of a plurality of labels in a single paper-fed process using the printer paper feed mechanism as indicated by Tracy at col. 2, lines 38-42.

4. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Van Valer, as applied to claim 18 above, and further in view of Levy (Pub. No. U.S. 2002/0146147 A1).

Clark, as modified by Van Valer, discloses all the basic limitations of the claimed invention except for the background printing.

Levy discloses encoded data of watermark to be printed on a label for an optical disk along with the printing the label's background on the label (paragraphs [0009]-[0011]).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device Clark with the aforementioned

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teaching of Levy. The motivation for doing so would have been to allow the verification of the authenticity of the optical disc.

***Allowable Subject Matter***

5. Claims 6-11, 14-17, 33-37, 39 and 40 are allowed.

***Response to Arguments***

6. Applicant's arguments filed 10/18/04 have been fully considered but they are not persuasive.

7. In response to applicant's argument that since Van Valer's methodology for labeling of compact disc with the area covering the center of the optical disc being excluded, "the combination of Van Valer and Clark is improper", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Clark teaches a method for labeling a compact disc wherein images are printed within an area that is substantially larger than the area required to cover at least one side of said storage area, e.g., the text and/or graphic being printed on the area covering the hole 23 of the optical disc. However, Clark fails to teach the printed images and a title corresponding to images and title encoded on the storage media, the label

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including at least one image that does not correspond to an image encoded on the storage media, and image that represents a musical selection encoded on said storage media. And Van Valer is cited as a remedy for what is known in the art for printing images and the title encoded on the compact disc. In this regard, Van Valer does not teach away from the claimed invention

8. Moreover, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L Talbott can be reached on (571) 272-1934. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HAI PHAM  
PRIMARY EXAMINER

December 20, 2004